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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,785

11/26/2003

Hajime Suda

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4144

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11/25/2008

PILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

ZHAO, DAQUAN

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,785	<b>Applicant(s)</b> SUDA, HAJIME	
	<b>Examiner</b> DAQUAN ZHAO	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/26/2003; 4/7/2005; 11/14/2005</u> .                        | 6) <input type="checkbox"/> Other: _____                          |



**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-4 in the reply filed on 8/13/2008 is acknowledged. The traversal is on the ground(s) that "no serious burden exists to search and examine the entire application". This is not found persuasive because of the following:

2. Restriction for examination purposes as indicated in the Requirement for Restriction/Election mailed in 7/21/2008 is proper because all these inventions listed in this action are independent or distinct for the reasons given and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

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3. Inventions I and II are related as combination and subcombination, wherein Invention I was classified in class 709, subclass 217 and invention II was classified in class 386, subclass 95. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, searching the combination as claimed does not require to search the particulars of the subcombination as claimed because group I does not require "a timer section which operates the information recording and playback section at a predetermined operation starting time, and stops the information recording and playback section at a predetermined operation ending time; a memory section which holds operation information of the timer section; a communications control section which inputs and sets at least the operation starting time and the operation ending time in the timer section from the outside" of group II. The subcombination has separate utility such as "a timer section which operates the information recording and playback section at a predetermined operation starting time, and stops the information recording and playback section at a predetermined operation ending time; a memory section which holds operation information of the timer section; a communications control section which inputs and sets at least the operation starting time and the operation ending time in the timer section from the outside".

1. Inventions I and III are related as combination and subcombination, wherein Invention I was classified in class 709, subclass 217 and invention III was classified in

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class 725, subclass 21 . Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, searching the combination as claimed does not require to search the particulars of the subcombination as claimed because Group I does not require “judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time and the operation ending time included in the recording control information contained in the mail whose recording programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively” of group III. The subcombination has separate utility such as “judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time and the operation ending time included in the recording control information contained in the mail whose recording programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively”.

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2. Inventions II and III are related as subcombinations disclosed as usable together in a single combination wherein Invention II was classified in class 386, subclass 95 and invention III was classified in class 725, subclass 21. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, searching subcombination III “judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time and the operation ending time included in the recording control information contained in the mail whose recording programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively” does not require to search invention II. See MPEP § 806.05(d).

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al (US 6,968,364 B1), hereinafter referenced as Wong.

For claim 1, Wong teach an information recording and playback apparatus which records or plays back information, comprising: receive means for receiving a recording programming mail from the outside (e.g. column 3, line50-65 and column 19, line 44-column 20, line 14, local computer receive email that contains a token from another remote computer), the recording programming mail containing programming contents (e.g. column 3, line50-65 and column 19, line 44-column 20, line 14, the token is an email); and entering means for entering a recording programming in accordance with the programming contents obtained by the receive means (e.g. column 3, line50-65 and column 19, line 44-column 20, line 14, PVR records the broadcast content according to the air time);

For claim 2, Wong teach an information recording and playback apparatus according to claim 1, the receive means receiving the recording programming mail through a network (e.g. figure 1, email token).

For claim 3, Wong teach an information recording and playback apparatus according to claim 1, further comprising: a notifying mechanism which notifies the outside of contents of the recording programming mail captured by the receive means (e.g. column 14, lines 62-64 figure 5 and column 19, lines 44-55 and figure 6, pop-up window, or the token itself can be the claimed "notifying mechanism").

For claim 4, Wong teach an information recording and playback apparatus according to claim 2, further comprising: a notifying mechanism which notifies the outside of contents of the recording programming mail received by the receive means (e.g. column 20, lines 34-44, yes button adds the token to a program list or the token itself can be the claimed "notifying mechanism").

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saito et al (US 7,088,952).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/  
Examiner, Art Unit 2621  
Daquan Zhao

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621